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DOCKET NO.: CING-0386/572.US **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
Steven T. Kanefsky; Michael Kocheisen;
David P. Kormann; and Bernard S. Renger

Confirmation No.: 3923

Application No.: 09/801,635

Group Art Unit: 2144

Filing Date: March 9, 2001

Examiner: Nguyen, Thanh T.

For: Method And Apparatus For Sharing Wireless Content

EXPRESS MAIL LABEL NO: EV 765639397 US
DATE OF DEPOSIT: September 25, 2006

EV765639397US

MS Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF TRANSMITTAL PURSUANT TO 37 CFR § 41.37

Transmitted herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal received by The United States Patent and Trademark Office on **December 22, 2005**.

☐ Applicant(s) has previously claimed small entity status under 37 CFR § 41.37 .

☐ Applicant(s) by its/their undersigned attorney, claims small entity status under 37 CFR § 1.27 as:

- ☐ an Independent Inventor
- ☐ a Small Business Concern
- ☐ a Nonprofit Organization.

☒ Petition is hereby made under 37 CFR § 1.136(a) (fees: 37 CFR § 1.17(a)(1)-(4) to extend the time for response to the Office Action of July 25, 2006 to and through September 25, 2006 comprising an extension of the shortened statutory period of one (1) month(s).

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DOCKET NO.: CING-0386/572.US **PATENT**

	SMALL ENTITY		NOT SMALL ENTITY	
	RATE	FEE	RATE	FEE
☐ APPEAL BRIEF FEE	$250	$	$500	$
☒ ONE MONTH EXTENSION OF TIME	$60	$	$120	$120.00
☐ TWO MONTH EXTENSION OF TIME	$225	$	$450	$
☐ THREE MONTH EXTENSION OF TIME	$510	$	$1020	$
☐ FOUR MONTH EXTENSION OF TIME	$795	$	$1590	$
☐ FIVE MONTH EXTENSION OF TIME	$1080	$	$2160	$
☐ LESS ANY EXTENSION FEE ALREADY PAID	minus	($)	minus	($)
TOTAL FEE DUE		$0		**$120.00**

☒ The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to Deposit Account 23-3050. This sheet is provided in duplicate.

☐ A check in the amount of **$ .00** is attached. Please charge any deficiency or credit any overpayment to Deposit Account No. 23-3050.

☒ Please charge Deposit Account No. 23-3050 in the amount of **$120.00**. This sheet is attached in duplicate.

☒ The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of the fees associated with this communication to Deposit Account No. 23-3050. **[Note: The Appeal Brief fee of $500.00 was previously paid by the law firm of Perkins Coie on April 20, 2006.]**

Date: September 25, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Mail Stop Appeal-Brief Patents
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Alexandria, VA 22313-1450

Sir:

APPELLANT'S BRIEF PURSUANT TO 37 C.F.R. § 41.37

This brief is being filed in support of Appellant's appeal from the rejections of claims 1-42 dated July 7, 2005. A Notice of Appeal was filed on December 22, 2005.

This brief supersedes the previously filed brief that was held to be non-compliant in the Notification of Non-Compliant Appeal Brief issued on July, 25, 2006.

Table of Contents

Table of Authorities

Cases

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is Cingular Wireless II, LLC, of Atlanta, Georgia, as a name change from previous AT&T Wireless, Inc., whose ownership was recorded August 20, 2001, at Reel and Frame: 012094/0050.

II. RELATED APPEALS AND INTERFERENCES

The applicant, the applicant's legal representative, and the real party in interest are unaware of any appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 42 claims pending in the application.

B. Current Status of Claims

1. Claims canceled: None.
2. Claims withdrawn from consideration but not canceled: None.
3. Claims pending: 1-42.
4. Claims allowed: None.
5. Claims rejected: 1-42.

C. Claims on Appeal

The claims on appeal are claims 1-42.

IV. STATUS OF AMENDMENTS

The applicant has not filed any amendments after the last Office Action of November 15, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Mobile and wireless devices employ the Wireless Access Protocol (WAP) to allow communication to and from the devices. The WAP is a secure protocol that enables a user to the real-time access of information, and is supported on many handheld device operating systems. These operating systems employ microbrowsers to provide content on the mobile device. Because the content is presented on a typically small screen of a mobile device, a special Wireless Markup Language (WML) was created to provide such content. Devices that employ microbrowsers and support WML (or WMLScript, which is a simplified version of JavaScript) may be referred to as WAP-enabled devices.1

Alternatively, the NTT DoCoMo i-mode is another protocol that enables a user to the real-time access of information with a mobile device. The "i-mode" does not use WAP. Instead, i-mode relies on Compact HTML (cHTML), a subset version of HTML that is intended for devices with slower connection speeds, such as mobile devices. Devices that contain i-mode microbrowsers may be referred to as i-mode enabled devices.2

WAP and/or i-mode enabled devices (collectively, "WAP/i-mode-enabled devices") have not been able to easily share content with one another across a network. In many cases, a user needs to manually enter content (such as a URL) into a message, and send the message from their WAP/i-mode enabled device to another device. Manual entry can be inconvenient, as a user is not able to observe content corresponding to a URL and manually enter the content at the same

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1 See Specification at page 1.

2 Id., page 2.

time. Additionally, the user will likely need to access an additional URL (such as a URL corresponding to sending email messages) and not be able to see the displayed content of the URL the user wishes to share. In these cases, a user of a WAP/I-mode enabled device may perform many inconvenient manual steps in order to share content with another user.[3]

In general, embodiments of applicant's invention allow the transmission of content from a WAP/i-mode-enabled mobile device to any other device across a network. (Spec. p. 4 ¶ 3). This is accomplished through various embodiments that are indicated in the following summary of claims.

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3 Id., page 3.

A. Summary of Claim 1

One embodiment of applicant's invention, recited in Claim 1 is directed to a method where the application server fetches the content corresponding to the URL and stores it in a cache for subsequent retrieval. The application server further creates a modified URL that effectively acts as a pointer to the data stored in the cache. The application server then transmits the modified URL corresponding to the newly-created deck or web page to the destination device. (Spec. Page 7, ¶ 3). The following references to the Specification and Drawings are merely illustrative, and other supporting information and illustrations may be found in the specification.

Subject Matter	Spec. Ref	Dwng. Ref.
A method for transmitting content ... from a first WAP/i-mode ... device to a second WAP/i-mode ... device	Page 11, ¶ 4	Fig. 2, generally
receiving a command from a first WAP/i-mode ... device for transmission of a first URL that is accessed by the first device, wherein the first device has received content associated by the first URL	Page 12, ¶ 1	Fig. 2, Step 220
receiving a destination address for transmission of the first URL, wherein the destination address is associated with the second device;	Page 12, ¶ 2	Fig. 2, step 240
generating a message including an indication of the second URL, wherein the second URL corresponds to the content received by the first device	Page 13, ¶ 2	Fig. 2, step 260
transmitting the message to the destination address, wherein the message can be used to access the content by the second device associated with the destination address	Page 12, ¶ 2	Fig. 2, Step 260

B. Summary of Claim 19

Subject Matter	Spec. Ref	Dwng. Ref.
A method for transmitting content from a WAP/I-mode-enabled device	Page 11, ¶ 4	Fig. 2, generally
receiving a command from a WAP/i-mode-enabled device for transmission of a first URL that is accessed by the device	Page 12, ¶ 1	Fig. 2, Step 220
receiving a destination address for transmission of the first URL	Page 12, ¶ 2	Fig. 2, step 240
generating a message including an indication of a second URL, a file associated with the second URL including a modified version of the content corresponding to the first URL; and	Page 13, ¶ 2	Fig. 2, step 250
transmitting the message to the destination address	Page 12, ¶ 2	Fig. 2, step 260

C. Summary of Claim 20

In one embodiment described in the specification, indications of URLs may be transmitted instead of actual URLs. An indication of a URL may be the actual URL, a pointer to the URL, or any other way of indicating the URL without explicitly including the URL. (Spec. Page 18, ¶ 2). This is reflected in claim 20.

Subject Matter	Spec. Ref	Dwng. Ref.
A method for transmitting content from a WAP/I-mode-enabled device	Page 4, ¶ 3	See Fig. 1, generally
receiving a first URL from a WAP/i-mode-enabled device in a command including an invoking script call;	Page 8, ¶ 2	Fig.2, step 220
receiving a destination address for transmission of the first URL;	Page 8, ¶ 3	Fig.2, Step 240
generating a message including a pointer to a second URL, wherein the pointer, second URL, or both relate to data accessible via the first URL; and	Page 18, ¶ 2	Fig. 5, step 260
transmitting the message to the destination address to permit a device associated with the second address to access the data	Page 5, ¶ 4	Fig. 5, step 260

D. Summary of Claim 30

Another embodiment of the invention allows the transmission of a URL or content corresponding to a URL without requiring any modification to enable the transmission functionality. In particular, embodiments of the invention do not require the addition of a link in content that is desired to be transmitted to enable the transmission functionality. Thus, any URL or content corresponding to a URL may be transmitted without any pre-processing required to enable the transmission functionality. (Spec. Page 21, ¶ 2) This is reflected in claim 30.

Subject Matter	Spec. Ref	Dwng. Ref.
A method for transmitting content, or information related to the content, from a WAP/I-mode-enabled device	Page 5, ¶ 4	Fig. 2, generally
receiving a command from a WAP/i-mode-enabled device for transmission of content corresponding to a URL;	Page 8, ¶ 2	Fig. 2, Step 220
receiving a destination address for transmission of the content;	Page 8, ¶ 3	Fig. 2, Step 240
storing the content for subsequent retrieval;	Page 7, ¶ 3	Fig. 5, Step 250
generating a message including the content; and	Page 16, ¶ 4	Fig. 5, Step 260
transmitting the message to the destination address, without any required pre-processing of the content or the URL to enable the transmission.	Page 21, ¶ 2	Fig. 5, Step 260

E. Summary of Claim 40

Another embodiment relates to computer readable medium to implement a method that that generates a message including an indication of the URL (Spec., Page 18, ¶3). This is reflected in claim 40.

Subject Matter	Spec. Ref	Dwng. Ref.
A computer-readable medium having stored thereon instructions ... initiate the transmission of content, or information related to the content, from a first WAP/i-mode-enabled telecommunications device to a second telecommunications device ...	Page 18, ¶ 3	Fig. 6, generally
receiving a command from a WAP/i-mode-enabled device that a URL accessed by the device will be transmitted, wherein the URL corresponds to content the first WAP/i-mode-enabled telecommunications device wishes to share with the second telecommunications device;	Page 8, ¶ 2	Fig. 2, step 220
receiving a destination address for transmission of the URL to the second telecommunications device, wherein the destination address is associated with the second telecommunications device;	Page 8, ¶ 4	Fig. 2 Step 240
generating a message including an indication of the URL; and	Page 9, ¶ 6	Fig. 2, step 260
transmitting the message to the destination address, wherein the message can be used to access the content by the second telecommunications device.	Page 9, ¶ 6	Fig. 2, step 260

F. Summary of Claim 41

Another embodiment of the invention is directed to computer-readable medium for transmitting content from WAP/i-mode-enabled device including instructions to generate a message including an indication of a second URL, or pointer, to the content. This is reflected in Claim 41.

Subject Matter	Spec. Ref	Dwng. Ref.
A computer-readable medium having stored thereon instructions ... initiate the transmission of content, or information related to the content, from a WAP/i-mode-enabled device	Page 18, ¶ 3	Fig. 6, generally
receiving a command from a WAP/i-mode-enabled device for transmission of a first URL that is accessed by the device, wherein the URL corresponds to content accessed by the device;	Page 12, ¶ 4	Fig. 2, Step 220
receiving a destination address for transmission of the content or the first URL;	Page 13, ¶ 3	Fig. 2, Step 240
storing the content, or revised version of the content, for subsequent retrieval;	Page 13, ¶ 3	Fig. 4, Step 250
generating a message including an indication of a second URL, or pointer, to the content; and	Page 13, ¶ 2	Fig. 4, Step 260
transmitting the message to the destination address to permit a device associated with the destination address to access the stored content.	Page 13, ¶ 2	Fig. 4, Step 260

G. Summary of Claim 42

Another embodiment of the invention relates to computer readable medium with instructions to store the content, or modified version of the content, for subsequent retrieval. This is reflected in Claim 42.

Subject Matter	Spec. Ref	Dwng. Ref.
A computer-readable medium ... initiate the transmission of content, or information related to the content, from a WAP/i-mode-enabled device	Page 18, ¶ 3	Fig. 6, generally
receiving a command from a WAP and i-mode-enabled device, or just i-mode enabled device, for transmission of content associated with a URL that is accessed by the device;	Page 8, ¶ 2	Fig. 2, Step 220
receiving a destination address for transmission of the URL or the content corresponding to the URL;	Page 8, ¶ 4	Fig. 2, Step 240
storing the content, or modified version of the content, for subsequent retrieval;	Page 13, ¶ 2	Fig. 5, Step 250
generating a message including the content, or modified version of the content, corresponding to the URL; and	Page 16, ¶ 1	Fig. 5, Step 260
transmitting the message to the destination address.	Page 16, ¶ 1	Fig. 5, Step 260

VI. GROUNDS OF REJECTION TO BE REVIEWED UPON APPEAL

A. Claim Rejections - 35 USC § 102

Claim 19 was rejected under 35 U.S.C. 102(e) as being anticipated by Nykanen. (USPN 6,661,784, December 9, 2003, Petri Nykanen.). The Examiner argued that Nykanen teaches a method for transmitting content from a "WAp/i-mode-enabled device comprising the steps of receiving a command from a WAp/i-mode-enabled device for transmission of a first URL that is accessed by the device (col.8, lines 10-1 5, col. 12, lines 25-3 1); receiving a destination address for transmission of the first URL (col.8, lines 16- 20, after receive the request and presented to user); generating a message including an indication of a second URL (col.8, lines 10-15, col. 12, lines 25-3 I), wherein the first URL and the second URL are identical, and transmitting the message to the destination address (co1.8, lines 16-20)."

B. Claim Rejections - 35 USC § 103

The Examiner rejected claims 1 and 2 as unpatentable under 35 USC § 103(a) over Nykanen, in view of Darago (USPN 6,170,014, January 2, 2001, Darago et al.). The Examiner asserted that Darago teaches that a message can be used to access the content by the second device associated with the destination address (see co1.2, lines 59-67, col.6, lines 60-67, and col.10, lines 26-38). The Examiner contends that it "would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Darago into the computer system of Nykanen to have the message can be used to access device associated with the destination address because it would have an utilization and convenient communications system that can use or enjoy something in one possesses."

The Examiner also rejected claims 3-8, 15-18 and 20-29 as unpatentable under 35 USC § 103(a) over Nykanen, in view of Darago.

The examiner rejected claims 9-14 as unpatentable under 35 USC § 103(a) over Nykanen, in view of Darago, further in view of Osaku (U.S. Patent No. 6,061,738, May 9, 2000,Osaku et al.) The Examiner contends that Osaku teaches the concept of caching the URL.

VII. ARGUMENTS

A. Rejections under 35 U.S.C. § 102(e)

1. Legal requirements for anticipation

35 U.S.C. § 102(e) provides:

> A person shall be entitled to a patent unless (e) the invention was described in -(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The M.P.E.P. at section 2131, states that "To anticipate a claim, the element must teach every element of the claim." Specifically, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaai Bros. v. Union Oil Co. of California, 81 4 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

2. The Nykanen Reference

Nykanen is directed to a method for setting up a data transmission connection between two devices. The connection is formed in order to transmit information from one device to a

second device. Nykanen explains that "[t]he purpose of the invention is particularly to define a system for communication between a WAP server and a WAP client..."[4]

Nykanen proceeds to define the system for communication, that is, to define the retrieval of information via a communication network between a communication device and another device, as follows:

> For retrieving information via the communication network, the communication device needs a WML browser and a HTTP WWW server coupled to the communication network, whereby the browser transmits a request to the selected server for retrieving the desired information, which is identified with the URL address. This information is given e.g. in the WML language which can be compared with the HTML language. After obtaining the information, it is possibly subjected to WMLIHTML conversion and presented to the user by means of the application used. Usually, also the URL addresses stored in the URL register of the communication device can refer to local services, such as teleVAS functions of the device itself, or to remote services, such as information of a server in the WML form. The URL register of the device contains advantageously a collection of URL addresses of known services.[5]

B. Nykanen fails to disclose a method for sharing content from a WAP/I-mode-enabled device to another device

As noted above, Nykanen discloses a method for establishing data transmission between two devices, but fails to disclose a method for sharing content transmitted from a wireless device. Embodiments of the invention extend the concept of facilitating data transmission between two communication devices well past what is disclosed in Nykanen by providing a method for storing and sharing content transmitted from a device. In other words, embodiments of the invention pick up where Nykanen leaves off: Nykanen discloses how to establish a connection and obtain data/content via a WAP device, while embodiments of the invention teach how to then easily share that data/content with another device.

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4 Nykanen, column 3, lines 9-13

5 Id. Column 8, lines 9-24.

C. Claim 19: Nykanen fails to show each and every element of the claim, and cannot, therefore, anticipate the claimed invention

Claim 19 is a method for transmitting content from a WAP/i-mode-enabled device, comprising:

receiving a command from a WAP/I-mode-enabled device for transmission of a first URL that is accessed by the device;

receiving a destination address for transmission of the first URL;

generating a message including an indication of a second URL, a file associated with the second URL including a modified version of the content corresponding to the first URL; and

transmitting the message to the destination address.

Nykanen does not show each and every element of claim 19. In fact, Nykanen is only similar to the claimed invention in that it discloses a URL being accessed by a WAP enabled device. Nykanen does not show "receiving a command from a WAP/i-mode- enabled device for transmission of a first URL that is accessed by the device." Furthermore, Nykanen does not show "receiving a destination address for transmission of the first URL," nor "generating a message including an indication of a second URL, a file associated with the second URL including a modified version of the content corresponding to the first URL." Finally, Nykanen does not show transmitting the message to the destination address."

The Examiner refers to column 8, lines 9-24 and column 12, lines 25-31 as evidence of Nykanen's alleged anticipation of claim 19. However, it is clear that these passages do not disclose each and every element of the claim. As cited and discussed above, Nykanen discloses, at lines 9-1 3: "For retrieving information via the communication network, the communication device needs a WML browser and a HTTP WWW server coupled to the communication network, whereby the browser transmits a request to the selected server for retrieving the desired information, which is identified with the URL address." Claim 19 does at least recite a "first URL that is accessed by the device."

Nykanen continues, at lines 14-18: "This information is given e.g. in the WML language which can be compared with the HTML language. After obtaining the information, it is possibly subjected to WMLIHTML conversion and presented to the user by means of the application used." Nykanen is still discussing information related to the retrieved URL, or, in the comparison with claim 19, the "first URL." The passage referred to by the Examiner concludes at lines 19-24 as follows: "Usually, also the URL addresses stored in the URL register of the communication device can refer to local services, such as teleVAS functions of the device itself, or to remote services, such as information of a server in the WML form. The URL register of the device contains advantageously a collection of URL addresses of known services." Nykanen is discussing content related to the retrieved URL. Nykanen, however, is not discussing "receiving a destination address for transmission of the first URL," or "generating a message including an indication of a second URL, a file associated with the second URL including a modified version of the content corresponding to the first URL," or "transmitting the message to the destination address," which are elements of claim 19.

In other words, Nykanen clearly does not mention the sharing of content from a WAP/i-mode-enabled device. At best, Nykanen is relevant only in that it discloses a WAP device obtaining content from a server. Therefore Nykanen, at least within column 8, lines 9-24, does not teach each and every element of claim 19.

The Examiner also uses column 12, lines 25-31 of Nykanen in supporting her determination of anticipation. Again, it is clear these passages also do not teach each and every element of claim 19, nor provide the elements lacking in the previously discussed passage. Like the earlier passage, Nykanen merely discloses that their system enables WAP access, and, if anything, is less relevant than the earlier discussed passage. Therefore Nykanen, at least within column 12, lines 25-31, does not teach each and every element of claim 1 9.

Thus, claim 19 is patentable over Nykanen.

D. Rejections under 35 U.S.C. § 103(a)

1. Legal requirements for obviousness

35 U.S.C. §103(a) provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

As stated in section 2142 of the MPEP, "to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." In re Vick, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A prima facie case of obviousness is established when the teachings from the prior art itself would have suggested the claimed subject matter to a person of ordinary skill in the art. In re Rockier, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d (BNA) 1955, 1956 (Fed. Cir. 1993) (citing In re Bell, 991 F.2d 781, 782, 26 U.S.P.Q.2d (BNA) 1529, 1531 (Fed. Cir. 1993)). "[T]he [E]xaminer bears the initial burden of presenting a prima facie case of obviousness." Id. at 1532.

To establish a prima facie case of obviousness, the Examiner must (a) identify prior art references that disclose all the elements of the claims, and (b) provide a suggestion or motivation to modify the references to produce the claimed invention. MPEP § 2143. With respect to the second requirement, the Examiner must provide a suggestion or motivation to combine from within the prior art, and may not rely upon hindsight gleaned from applicants' invention itself. See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050-51, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir. 1988).

Furthermore, "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

2. The applied references

a) The Nykanen reference

As discussed in detail above, Nykanen is directed to a method for setting up a data transmission connection between two devices. The connection is formed in order to transmit information from one device to a second device. Nykanen explains that "the purpose of the invention is particularly to define a system for communication between a WAP server and a WAP client..." [6]

b) The Darago et al. Reference

Darago is directed to computer architecture for managing courseware in a shared use operating environment. Darago explains that "the present invention is concerned with network-

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[6] Nykanen, column 3, lines 9-13.

based courseware delivery systems."[7] Darago further explains that "the architecture of the present invention provides improved security, efficiency, and convenience for the management of courseware or other content in a shared operating environment such as a network or a collection of loosely coupled networks." [8]

For example, the system of Darago is implemented as a networked courseware delivery system that provides a content server which may contain courseware and other managed content that can be accessed by users (such as students) of the system.j3[9] In order to provide this capability, the system "operates in a network containing a registration server, a content server connected to the registration server, and several client workstations connected to the content server." [10] Users may then register with the system via the registration server. The content server then authenticates users. After authentication, the content server provides content to the user at a client workstation. [11] Darago does not discuss mobile or cellular phones.

c) The Osaku Reference

Osaku is directed to a method and system for accessing information on a network using message aliasing functions having shadow callback functions. As Osaku explains, "the present invention provides novel methods and systems for accessing a network URL through pre-assigned, simplified network addresses, often using a single number of one or more digits, and for then displaying the home page corresponding to the simplified network address."[12]

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[7] Darago, column 2, lines 55-56.

[8] Id., column 6, lines 60-63.

[9] Id., Figures 3-4.

[10] Id., column 6, lines 1-4.

[11] Id., column 6, lines 1-14 and Figure 1.

[12] Osaku, column 1, line 66 to column 2, line 2.

E. Osaku, column 1, line 66 to column 2, line 2.

Under the above standards, applicants' invention would not have been obvious for lack of prima facie case. For at least the reasons described in greater detail below, the Examiner has failed to satisfy her burden of presenting a prima facie case of obviousness because the Examiner has not identified prior art references that disclose all the elements of the pending claims. For example, several pending claims include, inter alia, the feature of sharing data/content from a WAP/i-mode-enabled device to another device. As explained in greater detail below, none of the cited references teach or suggest this feature. Possibly more importantly, the Examiner has not provided sufficient or cogent motivation from within the prior art to modify the cited references to produce the claimed invention. For at least these reasons, a prima facie case has not been established, and the pending claims should be allowed.

F. Claims 1-18 and 20-42: Nykanen, Darago et al. and Osaku fail to disclose the sharing of content from a WAP/I-mode-enabled device to another device

As noted above, Nykanen discloses how to establish a connection and obtain data/content via a WAP device, but does not disclose the sharing of the data/content from a WAP/i-mode-enabled device to another device.

Darago fails to make up for the deficiencies of Nykanen. For the purposes of this discussion, Darago merely shows a shared use operating environment where different client workstations are able to access the same content at a content server. Darago simply fails to provide any discussion of sharing content between a WAP/i-mode-enabled device and another device.

Osaku, likewise, simply fails to provide any discussion of sharing content between a WAP/i-mode-enabled device and another device, as Osaku is directed to accessing URLs using simplified addresses.

Thus, Nykanen, Darago and Osaku fail to disclose (or fairly suggest) any method of sharing content between devices, which is a thrust of claims 1-18 and 20-42. Claims 1-8 and 15-1 8 are directed to methods of sharing content between two WAP/i-mode-enabled devices. Claims 20-39 are directed to methods of transmitting content from a WAPli- mode-enabled device. Claims 40-42 are directed to computer-readable media whose contents cause a WAP/i-mode-enabled device to initiate transmission of content from the device to a destination. Thus, claims 1-18 and 20-42 are patentable because Nykanen, Darago and Osaku fail to disclose or fairly suggest a system or method of sharing content between a WAP/i-mode-enabled device and another device.

Furthermore, The Examiner has not provided a suggestion or motivation to modify the references to produce the invention as recited in claims 1-18 and 20-42. For example, in order to combine Nykanen with Darago, the Examiner states "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Darago into the computer system of Nykanen to have the message can be used to access device associated with the destination address because it would have an utilization and convenient communications system that can use or enjoy something in one possesses." [13] As best the applicant can tell, the Examiner is relying on Darago's disclosure of sharing content as the reason for combining the two references.

Nykanen, however, does not discuss the sharing of content between mobile devices. Instead, "the "purpose of [Nykanen] is particularly to define a system for communication between a WAP server and a WAP client complying with the WAP application protocol in the area of a piconet utilising IR or SPRF services and utilising this piconet."[14] Therefore, one of ordinary skill in the art would not look to Darago's system of computer architecture for managing courseware in a shared use operating environment.

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[13] July 27, 2005 Office Action, page 4.

[14] Nykanen, column 3, lines 10-1 5.

Additionally, because Darago is directed to computer architecture to manage courseware, it can not be considered analogous art. Furthermore, there is no suggestion that Darago would have commended itself to Nykanen in considering his problem. Therefore, the combination of Nykanen and Darago is impermissible as (1) the Examiner does not provide a suggestion or motivation to combine from within the prior art and (2) the cited references are not analogous art.

Claims 1-18 and 20-42 are taken as a group.[15]

Claim 1 is directed to a method for transmitting content, or information related to the content, from a first WAP/i-mode-enabled device to a second WAP/I-mode-enabled device, the method comprising "receiving a command from a first WAP/I-mode enabled device for transmission of a first URL that is accessed by the first device ...receiving a destination address for transmission of the first URL. ..generating a message including an indication of

[a] second URL, wherein the second URL corresponds to content received by the first device, and transmitting the message to the destination address."

As discussed above, Nykanen discloses how to establish a connection and obtain data/content (such as content accessed through a URL) via a WAP device. Nykanen, however, does not disclose or suggest a WAP device sharing the obtained content with another WAP device. Specifically, Nykanen does not disclose or suggest sharing content between WAP/i-mode-enabled devices by "receiving a command" for transmission of a URL, "receiving a destination address," "generating a message," or "transmitting the message to the destination address" as is recited in claim 1.

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[15] The applicant has grouped the claims to simplify issues on appeal. The applicant, however, does not admit that the claims in any group stand or fall together for purposes other than this appeal. In particular, the applicant reserves the right to argue the patentability of each claim separately in a subsequent action, such as reopened prosecution or litigation.

Darago also does not provide these elements. As noted above, Darago discloses a network architecture where multiple client workstations are able to access the same content contained on a content server within the network. Darago, therefore, also does not disclose or suggest sharing content between WAP/I-mode-enabled devices by "receiving a command" for transmission of a URL, "receiving a destination address," generating a message," or "transmitting the message to the destination address" as is recited in claim 1.

The combination of Nykanen and Darago does not disclose each and every element of claim 1, and therefore claim 1 is patentable over Nykanen and Darago. The remaining claims in this group are patentable for similar reasons.

Dependent claims 2-18 include all the limitations of independent claim 1, and are thus patentable for similar reasons.

Claim 20 is similar to claim 1, but is directed to a method for transmitting content from a WAP/I-mode-enabled device to a destination address. Dependent claims 21-29 include all the limitations of independent claim 20, and are thus patentable for similar reasons.

Claim 30 includes limitations similar to those described above with respect to claims 1 and 20, including elements directed to storing the content before transmitting the message to the destination address, and is thus similarly patentable. Claims 31-39 are dependent on claim 30 and are thus similarly patentable.

Claims 40-42 are directed to computer readable media and include limitations similar to those described above with respect to claims 1, 20 and 30, and are this similarly patentable.

In sum, claims 1-18 and 20-42 are patentable because Nykanen and Darago at least fail to disclose (or fairly suggest) the sharing of content between a WAP/I-mode- enabled device and another device or destination address.

Furthermore, as discussed above, claims 1-18 and 20-42 are likewise patentable because the Examiner does not provide a suggestion or motivation to combine the two references from within the prior art. Instead, the Examiner relies on her own opinion that "[a] utilization and convenient communications system that can use or enjoy something in one possesses" would motivate one of ordinary skill in the art to combine Nykanen with Darago.

VIII. CLAIMS APPENDIX

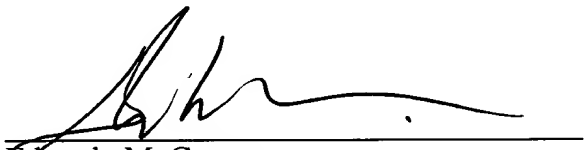
A copy of the claims involved in the present appeal is attached hereto as Appendix A.

IX. EVIDENCE APPENDIX

None.

The Commissioner is hereby authorized to charge shortages or credit overpayment to Deposit Account No. 23-3050.

Date: September 25, 2006



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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 091801,635

1. A method for transmitting content, or information related to the content, from a first WAP/i-mode-enabled device to a second WAP/i-mode-enabled device, the method comprising:

receiving a command from a first WAP/i-mode-enabled device for transmission of a first URL that is accessed by the first device, wherein the first device has received content associated by the first URL;

receiving a destination address for transmission of the first URL, wherein the destination address is associated with the second device;

generating a message including an indication of the second URL, wherein the second URL corresponds to the content received by the first device; and

transmitting the message to the destination address, wherein the message can be used to access the content by the second device associated with the destination address.

2. The method of claim 1 wherein the first URL and the second URL are identical

3. The method of claim 1 wherein the command includes an invoking script call containing the first URL as an argument.

4. The method of claim 1 wherein the indication is a pointer to the second URL, and a file associated with the second URL includes a pointer to the first URL.

5. The method of claim 4 wherein the file associated with the second URL contains advertising.

6. The method of claim 1 wherein the indication is a pointer to the second URL.

7. The method of claim 1 wherein the indication includes the second URL.

8. The method of claim 1 wherein the first URL is currently-accessed by the WAP/I- mode-enabled device.

9. The method of claim 1 wherein the content corresponding to the first URL is cached.

10. The method of claim 9 wherein a file corresponding to the second URL includes the cached content.

11. The method of claim 9 wherein a file corresponding to the second URL includes a modified version of the cached content.

12. The method of claim 11 wherein the modified version of the cached content includes advertising.

13. The method of claim 11 wherein the modified version of the cached content is in a format capable of being rendered on a destination device at the destination address.

14. The method of claim 13 wherein the format for the modified version of the cached content is selected based on the destination device.

15. The method of claim 1 wherein the first URL is a previously-accessed URL and is retrieved from a history stack prior to the receiving of the command.

16. The method of claim 1 wherein the first URL is a previously-accessed URL and is retrieved from a list of bookmarks prior to the receiving of the command.

17. The method of claim 1 wherein the WAP/i-mode-enabled device is a device that is WAP-enabled, but not i-mode-enabled.

18. The method of claim 1 wherein the WAP/i-mode-enabled device is a device that is i-mode-enabled, but not WAP-enabled.

19. A method for transmitting content from a WAP/I-mode-enabled device, the method comprising:

receiving a command from a WAP/i-mode-enabled device for transmission of a first URL that is accessed by the device;

receiving a destination address for transmission of the first URL;

generating a message including an indication of a second URL, a file associated with the second URL including a modified version of the content corresponding to the first URL; and

transmitting the message to the destination address.

20. A method for transmitting content from a WAP/i-mode-enabled device, the method comprising:

receiving a first URL from a WAP/i-mode-enabled device in a command including an invoking script call;

receiving a destination address for transmission of the first URL;

generating a message including a pointer to a second URL, wherein the pointer, second URL, or both relate to data accessible via the first URL; and

transmitting the message to the destination address to permit a device associated with the second address to access the data.

21. The method of claim 20 wherein the first URL and the second URL are identical.

22. The method of claim 20 wherein a file associated with the second URL contains a pointer to the first URL.

23. The method of claim 20 wherein a file associated with the second URL contains advertising.

24. The method of claim 20 wherein a file associated with the second URL contains a modified version of the content corresponding to the first URL.

25. The method of claim 24 wherein the modified version of the content is in a format suitable for rendering on a destination device at the destination address.

26. The method of claim 20 wherein the first URL is a previously-accessed URL and is retrieved from a history stack prior to the receiving of the command.

27. The method of claim 20 wherein the first URL is a previously-accessed URL and is retrieved from a list of bookmarks prior to the receiving of the command.

28. The method of claim 20 wherein the WAP/i-mode-enabled device is a device that is WAP-enabled, but not i-mode-enabled.

29. The method of claim 20 wherein the WAP/I-mode-enabled device is a device that is i-mode-enabled, but not WAP-enabled.

30. A method for transmitting content, or information related to the content, from a WAP/I-mode-enabled device, the method comprising:

receiving a command from a WAP/i-mode-enabled device for transmission of content corresponding to a URL;

receiving a destination address for transmission of the content;

storing the content for subsequent retrieval;

generating a message including the content; and

transmitting the message to the destination address, without any required pre-processing of the content or the URL to enable the transmission.

31. The method of claim 30 wherein the content includes advertising inserted by an application server.

32. The method of claim 30 wherein the content is translated into a format different from the format of the content rendered on the WAP/i-mode-enabled device, before inclusion of the content into the message.

33. The method of claim 32 wherein the format into which the content is translated can be properly rendered by a destination device at the destination address.

34. The method of claim 33 wherein the format into which the content is translated is selected based on the destination device at the destination address.

35. The method of claim 34 wherein the format into which the content is translated is selected based on a connection with the destination device at the destination address.

36. The method of claim 30 wherein the URL is a previously-accessed URL and is retrieved from a history stack prior to the receiving of the command.

37. The method of claim 30 wherein the URL is a previously-accessed URL and is retrieved from a list of bookmarks prior to the receiving of the command.

38. The method of claim 30 wherein the WAP/i-mode-enabled device is a device that is WAP-enabled, but not i-mode-enabled.

39. The method of claim 30 wherein the WAP/i-mode-enabled device is a device that is i-mode-enabled, but not WAP-enabled.

40. A computer-readable medium having stored thereon instructions adapted to be executed by a processor, the instructions, which when executed, initiate the transmission of content, or information related to the content, from a first WAP/i-mode-enabled telecommunications device to a second telecommunications device, the instructions including:

receiving a command from a WAP/i-mode-enabled device that a URL accessed by the device will be transmitted, wherein the URL corresponds to content the first WAP/i-mode-enabled telecommunications device wishes to share with the second telecommunications device;

receiving a destination address for transmission of the URL to the second telecommunications device, wherein the destination address is associated with the second telecommunications device;

generating a message including an indication of the URL;

and transmitting the message to the destination address, wherein the message can be used to access the content by the second telecommunications device.

41. A computer-readable medium having stored thereon instructions adapted to be executed by a processor, the instructions, which when executed, initiate the transmission of content, or information related to the content, from a WAP/i-mode-enabled device, the instructions including:

receiving a command from a WAP/i-mode-enabled device for transmission of a first URL that is accessed by the device, wherein the URL corresponds to content accessed by the device;

receiving a destination address for transmission of the content or the first URL;

storing the content, or revised version of the content, for subsequent retrieval;

generating a message including an indication of a second URL, or pointer, to the content; and

transmitting the message to the destination address to permit a device associated with the destination address to access the stored content.

42. A computer-readable medium having stored thereon instructions adapted to be executed by a processor, the instructions, which when executed, initiate the transmission of content, or information related to the content, from a WAP/i-mode-enabled device, the instructions including:

receiving a command from a WAP and i-mode-enabled device, or just i-mode enabled device, for transmission of content associated with a URL that is accessed by the device;

receiving a destination address for transmission of the URL or the content

corresponding to the URL;

storing the content, or modified version of the content, for subsequent

retrieval; generating a message including the content, or modified version of the content, corresponding to the URL; and

transmitting the message to the destination address.

APPENDIX B
EVIDENCE APPENDIX

No evidence has been entered or is being relied upon in the present appeal.

APPENDIX C
RELATED PROCEEDINGS

There are no decisions rendered by a court or the Board in any proceeding identified in the Related Appeals and Interferences section.